

Attorney Docket No.: 6425/1

REMARKS

Claims 1-17 are currently pending in this application. Claims 1, 6, 7 and 9-11 have been amended, and claims 13-17 have been added, by this Amendment.

The Office Action dated September 24, 2004 rejected claim 1 as being indefinite under 35 USC 112, second paragraph, and as being anticipated by prior art under 35 USC 102(b). Applicants gratefully acknowledge the indication that claims 2-12 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Foreign Priority

Applicant submitted a certified copy of the foreign priority document on March 19, 2004. However, the Office Action does not acknowledge the submission of the foreign priority document. Applicant requests that the next Office Action or Notice of Allowance acknowledge that the certified copy of the foreign priority document has been received.

Information Disclosure Statement

Applicant submitted an Information Disclosure Statement (IDS) on April 29, 2004 citing two references. The Examiner was requested to indicate his or her consideration of the documents cited in the IDS by initialing the Citation List adjacent the citation of each document and returning the initialed list with the Office Action. Although one of the two references in the IDS was applied by the Examiner in a prior art rejection in the outstanding Office Action, the other reference was not mentioned in the Office Action. Applicant thus repeats the request that the Examiner initial the Citation List adjacent the citation of each document and return the list with the next Office Action or Notice of Allowance.

Indefiniteness Rejection

The grounds for the rejection of claim 1 as being indefinite under 35 USC 112, second paragraph, is set forth in paragraph 3 on page 2 of the Office Action. The rejection points out errors in claim 1 and applicant has amended claim 1 to overcome the errors. The rejection refers to the passageway "in combination with" said two stops, however claim 1 does not recite such a

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combination. Applicant has not amended claim 1 to recite "how" the protective element is friction-fixed, since 35 USC 112, second paragraph, does not require that specifics be recited.

Anticipation Rejection

The grounds for the rejection of claim 1 as being anticipated by prior art under 35 USC 102(b) is set forth in paragraph 5 on page 3 of the Office Action. Specifically, the rejection states that claim 1 is anticipated by the device illustrated in German Patent Publication No. 1,884, 208 (the device hereinafter referred to as "the '208 device" for the sake of simplicity). Applicant respectfully traverses the rejection on the grounds that the rejection does not establish a prima facie case that the '208 device includes each and every one of the combination of features recited in claim 1.

For example, claim 1 recites a protective element that prevents any contact with the surface to be polished. The rejection relies upon element 11 of the '208 device as the recited protective element that prevents any contact with the surface to be polished. However, the '208 device has a frontal area 10 inside a recess of discs 5 and 6 so that the protective element 11 is not flush with the ring-shaped polishing surface 12. From this, it directly follows that element 11 is arranged behind the polishing area because otherwise contact between element 11 and the surface to be polished could not be excluded. Since screws 8 are arranged within element 11, such contact would cause damages to the surface to be polished.


Claim Amendments

Claims 6, 7 and 9-11 have been amended merely to correct errors discovered in the dependency of the claims. New claims 13-17 have been added. Claim 13 is substantially similar to claim 1 except that it additionally recites a plurality of polishing disks, and claims 14-17 are dependent on claim 13. Claims 13-17 are thus submitted to be allowable for at least the same reasons as claim 1.

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The Commissioner is hereby authorized to charge any fee necessary for the consideration of this paper, or to avoid abandonment of the application, to the undersigned attorney's Deposit Account No. 02-4270 (Dkt. No. 6425/1US).

Respectfully Submitted,

A handwritten signature in cursive script, reading "Robert Bauer", is written over a horizontal line.

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